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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/992,914	12/18/97	WATANABE E	0020-4348P

HM21/0701  
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EXAMINER  
ZAGHMOUNT, O

ART UNIT	PAPER NUMBER
1549	6

DATE MAILED: 07/01/98

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

Please see attached

# Office Action Summary

Application No.  
**08/992,914**

Applicant(s)  
**Watanabe et al.**

Examiner  
**Ousama Zaghmout**

Group Art Unit  
**1649**



☒ Responsive to communication(s) filed on Dec 18, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire one month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-39 is/are pending in the applicat

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-39 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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**Please Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Donald E. Adams, Ph.D., Supervisory Patent Examiner at Donald.Adams@uspto.gov or 703-308-0570. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

**Election/Restriction**

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-19, 29-36 are drawn to nucleic acid molecule encoding a full length of the gene of a raffinose synthase, vectors containing it in sense orientation, methods for their use to transform plants, and the resultant plants, classified in class 800, subclass 205 for example.
- II. Claim 20 is drawn to a raffinose synthase protein, classified in class 530, subclass 300, for example.
- III. Claims 21-23 are drawn to a gene fragment comprising less than full length raffinose synthase gene, classified in class 536, subclass 24.3 for example.
- IV. Claims 24-25, 28 are drawn to a method for the detection of a full length or fragment by hybridization, classified in class 535, subclass 6 for example.

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V. Claims 26 -27 are drawn to a method for the detection of a full length or fragment by amplification by polymerase Chain Reaction (PCR), classified in class 535, subclass 6 for example.

VI. Claim 37 is drawn to a method for the production of a raffinose synthase protein, classified in class 535 subclass 69.1 for example, classified in class 536, subclass 23.4 for example.

VII. Claims 38-39 are drawn to antibody to a raffinose synthase protein, classified in class 530, subclass 387.1+ for example.

The inventions are distinct, each from the other because each is drawn to physiologically, biochemically, and molecularly divergent products and processes not required by the other.

The invention of group I involves nucleic acid molecule encoding a full length of the gene of a raffinose synthase, vectors containing it in sense orientation, methods for their use to transform plants, and the resultant plants, not required by any other group.

The invention of group II involves the a raffinose synthase protein. Furthermore, the protein could be made by a process other than the expression of the gene of group I, such as chemical synthesis.

The invention of group III involves less than full length raffinose synthase gene, not required by any other group. Furthermore, the full length of raffinose synthase gene of group I not required for the invention of group II.

The invention of group IV involves a method for the detection of a full length or fragment by hybridization, not required by any other group. Furthermore, the invention of group

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V comprising the isolation of nucleotide sequences by amplification with PCR, a completely different process than hybridization.

The invention of group V involves a method for the detection of a full length or a fragment by amplification with PCR, not required by any other group. Furthermore, the invention of group IV comprising the isolation of nucleotide sequences by hybridization, a completely different process for isolation of nucleotide sequence than the amplification with PCR.

The invention of group VI involves the production of a raffinose synthase protein, not required by any other group for the reasons stated above.

The invention of group VII involves antibodies not required by any other group.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their divergent subject matter, classification, and fields of search, restriction for examination purposes as indicated is proper.

A telephone call was made to Gerald M. Murphy on May 11, 1998 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently amendment of inventorship must be accompanied by a diligently-filled petition under 37 CFR 1.148(b) and the fee required under 37 CFR 1.17(h).

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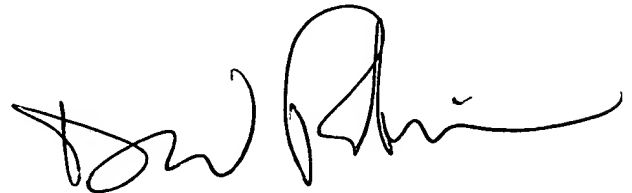
**Future Correspondence**

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Ousama M-Faiz Zaghmout whose telephone number is (703) 308-9438. The Examiner can normally be reached Monday through Friday from 7:30 am to 5:00 pm (EST).

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Douglas Robinson, can be reached on (703) 308-2897. The fax phone number for the group is (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application should be directed to THE MATRIX CUSTOMER SERVICE CENTER whose telephone number is (703) 308-0196.

Ousama M-Faiz Zaghmout Ph.D.  
June 29, 1998

A handwritten signature in black ink, appearing to read 'Douglas W. Robinson', with a stylized, cursive script.

Douglas W. Robinson  
Supervisory Patent Examiner  
Technology Center 1600